

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL ANTHONY JOHN NOLAN

Appeal No. 2006-0922
Application No. 09/802,963

ON BRIEF



Before JERRY SMITH, BLANKENSHIP, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-8.

Invention

Appellant's invention relates to a method and apparatus for creating visual effects in a pixel image display.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. Apparatus for creating an emblazoning effect in a graphical image, comprising:

(a) a processor;

(b) a primary buffer for storing primary pixel values representing a region,

(c) a secondary buffer for storing secondary pixel values representing a region,

(d) a user-modifiable alpha channel for storing tertiary values for pixels representing the same region,

(e) an alpha channel filter function representing application of both color values and brightness values to input pixel values, wherein said processor executes said function on the secondary pixel values an extent represented by the tertiary pixel values held in the alpha channel, for storing the resultant pixel values as the primary pixel values, in the primary buffer,

(f) user-activated means for copying the primary pixel values stored in the primary buffer to the secondary pixel values stored in the secondary buffer.

References

The references relied on by the Examiner are as follows:

| | | |
|--------------------------|-----------|-----------------------|
| Long | 5,412,767 | May 02, 1995 |
| Decoste et al. (Decoste) | 6,317,142 | Nov. 13, 2001 |
| | | (Filed April 3, 1998) |

Rejections At Issue

Claim 2 stands rejected under 35 U.S.C. § 102 as being anticipated by Decoste.

Claims 3-4 stand rejected under 35 U.S.C. § 102 as being anticipated by Long.

Claims 1 and 5-8 stand rejected under 35 U.S.C. § 103 as being obvious over Long.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated **infra**, we affirm the Examiner's rejection of claim 2 under 35 U.S.C. § 102; we affirm the Examiner's rejection of claims 1, 5, 6, and 8 under 35 U.S.C. § 103; we reverse the Examiner's rejection of claims 3-4 under 35 U.S.C. § 102; and we reverse the Examiner's rejection of claim 7 under 35 U.S.C. § 103.

I. Whether the Rejection of Claim 2 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Decoste does fully meet the invention as recited in claim 2. Accordingly, we affirm.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v.**

¹ Appellant filed an appeal brief on December 6, 2004. Appellant filed a reply brief on March 25, 2005. The Examiner mailed an Examiner's Answer on April 12, 2005.

American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 2, Appellant argues at page 13 of the brief, "[u]nlike Decoste, which teaches reducing the transparency of the edges of a brush stroke, the Applicant's invention teaches reducing the transparency of the edges of the selected media image." We disagree.

Appellant's specification at page 1 defines "media" as "a representation of the tool the user paints with" and defines "media image" as an "image representing the currently selected tool." Therefore, the claimed step of "causing edges of the media image to have less transparency" is read as reducing the transparency of the edges of the image of a tool. Contrary to Appellant's contention that Decoste is directed only to the "brush stroke," Decoste states at column 15, lines 13-14 that "a soft brush edge has an adjustable gradient that gives the edge a soft or fuzzy appearance." We find that Decoste describes reducing the transparency of the edges of the image of the "brush" (i.e., tool or media).

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

**II. Whether the Rejection of Claims 3-4 Under
35 U.S.C. § 102 is proper?**

It is our view, after consideration of the record before us, that the disclosure of Long does not fully meet the invention as recited in claims 3-4. Accordingly, we reverse.

With respect to independent claim 3, Appellant argues at page 15 of the brief, "[n]owhere does Long teach the alteration of an image defined by the alpha channel, after the image has been defined." We agree.

The Examiner sets forth the basis for the rejection at pages 5-6 of the answer. The entire rejection of claim 3 is based on repeatedly referring to columns 4-6 without explanation in most instances. The sole explanation provided is of the term "brightening." Also, the Examiner states as an example from Long, "a soft brush edge having an adjustable gradient." However, the Long patent does not contain either of the following words "adjustable," or "gradient." Even accepting the Examiner's explanation of "brightening," we do not find before us an explanation that demonstrates the claimed invention is described in the Long patent. At best we find an invitation to the Applicant (and this Board) to construct the explanation from the cited columns in Long. We decline this invitation. Additionally, the Examiner's explanations of Long in the answer do not correct for the Examiner's failure to meet the initial burden of establishing a **prima facie** case of anticipation.

The rejection of claim 4 shares the problem of claim 3. We also note that the rejection at page 6 of the answer refers to figure 12A and column 15, lines 24-31. The Long patent does not have this figure or this column. Rather, they are found in the Decoste patent.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

**III. Whether the Rejection of Claim 1 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claim 1. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). ***See also In re Piasecki***, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter.

In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of

coming forward with evidence or argument shift to the Appellant. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellant argues at page 20 of the brief, "[t]he limitations of Claim 1 are not obvious under Long" because "[w]hile Long may teach providing means for copying, Long does not teach a user-activated means for doing so." "Nor would such a modification have been obvious." We disagree.

To determine whether claim 1 is obvious over the references, we must first determine the scope of the claim. Appellant's specification shows the claimed "user-activated means for copying" at page 3 in the Brief Description as "a user-activated means for copying." Note that this is Appellant's sole disclosure of this feature, as it does not appear in either

Appellants' Detailed Description or figures. Appellant argues that "user-activated" should be narrowly defined as "facilitating a greater degree of control." In fact, Appellant's disclosure shows no such limitation. Nor does the Appellant's disclosure place any limitation on how the user activates the "means for copying."

Our reviewing court states in **In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." **Texas Digital Sys. Inc v. Telegenix Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), **cert. denied**, 538 U.S. 1058 (2003).

Upon our review of Appellant's specification, we fail to find any definition of the term "user-activated" that is different from the ordinary meaning. We find the ordinary meaning of the term "user-activated means for copying" is simply --means for copying that is activated in any manner by the user--. As the Examiner correctly points out in the answer at page 12 "Long at least teaches an indirect user activated means (artist's touch tablet)." We find that nothing more than Long's teaching is required by the claim language.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

IV. Whether the Rejection of Claim 5 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claim 5. Accordingly, we affirm.

With respect to independent claim 5, Appellant argues at pages 21-22 of the brief, "the alpha channel is not user-modifiable in and of itself," thus "claim 5 is patentable over Long." We disagree. As above with "user-activated," the term "user-modifiable" places no special limitation on the claimed alpha channel except that the user is able to make a modification in any manner. The Examiner has set forth at page 21 of the answer a manner in Long for making such a modification.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

V. Whether the Rejection of Claim 6 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in

the art the invention as set forth in claim 6. Accordingly, we affirm.

Appellant argues at page 22 of the brief, Claim 6 adds features not taught by Long because "Applicant's invention allows the user to, with a single step, cause the edges of the selected image to have less transparency," and "Long would require ... a series of brush strokes." We disagree. Claim 6 fails to recite the "single step" language argued by Appellant. Nor has Appellant pointed to any language in the claim that requires the "single step" limitation.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

**VI. Whether the Rejection of Claim 7 Under
35 U.S.C. § 103 is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claim 7. Accordingly, we reverse.

With respect to dependent claim 7, at page 23 of the brief again Appellant argues claim limitations that are not found in the claim. Nor does Appellant point to any claim language that requires such a limitation. We find this argument wholly unpersuasive.

In the reply brief Appellant further argues with respect to claim 7 (based on Appellant's reference to page 24 of the answer discussing claim 7), that "[Long's] modified pixels and destination pixels are not the same as the alpha channel pixels of Applicant's invention." The Examiner provides no response to this point. Given Appellant's specification at page 2 provides a specific definition of "alpha channel" and the Examiner's rejection of claim 7 does not specifically point out which feature in Long meets the claim limitation. The Examiner merely pointing to column 4, lines 40-43, and column 5, lines 14-17, without explanation is not sufficient.

Therefore, we are forced to agree with Appellant and we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

**VII. Whether the Rejection of Claim 8 Under
35 U.S.C. § 103 is proper?**

Appellant fails to separately argue claim 8. Rather, at pages 23-24 of the brief, Appellants merely state the features of this claim and allege, without explaining why, that the additional features render the claim separately patentable. The rules in effect at the time the brief was filed specifically address the weight to be given the statements and allegations presented by Appellants. See 37 CFR § 41.37 (c) (1) (vii) (2005, which became effective September 13, 2004 (69 Fed. Reg. 49960 (Aug 12, 2004))):

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A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

Appellants have not discussed why the evidence would support a holding that claim 8 is patentable apart from claim 5. Therefore, we will sustain the Examiner's rejection of claim 8 under 35 U.S.C. § 103 as standing or falling with the patentability of claim 5.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claim 2; we have not sustained the rejection under 35 U.S.C. § 102 of claims 3-4; we have sustained the rejection under 35 U.S.C. § 103 of claims 1, 5, 6, and 8; and we have not sustained the rejection under 35 U.S.C. § 103 of claim 7.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED-IN-PART

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